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10/530,806	04/08/2005	Dharam Pal		9302

7590 11/15/2007		
Ramesh Babu Vishwanath	**EXAMINER**	
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Hunderabad, 500016	ART UNIT	PAPER NUMBER
INDIA	3694	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>08 April 2005</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-9</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-9</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☒ Some *   c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This is the first Office Action in response to the application filed on April 8th, 2005 and titled: "An On-Line Credit Information System".

Oath/Declaration Objections

2.   The Oath signed on March 12, 2005 by the inventor, "PAL, DHARAM", in India is objected to as being informal. It lacks authentication by a diplomatic or consular officer of the United States; 37 CFR 1.66(a). This informality can be overcome by filing either a declaration under 37 CFR 1.68, or a new properly authenticated oath under 37 CFR 1.66. Examiner also notes that no line/row in the upper right hand box has been filled-in, including the Inventor's Name, in the instant Oath filed to the Office. The new Oath or Declaration must properly identify the application of which it is to form a part, preferably by application number and filing date, in the body of the Oath or Declaration. See MPEP §§ 602.01 and 602.02.

Appropriate correction is required.

Foreign Priority Claim Objections

3.   Acknowledgment is made of the Applicant's claim for foreign priority based on an application filed in Singapore on November 18, 2002 and a PCT filed in India on November 17, 2003, which is the basis for their 371 application in US. It is noted,

however, that the Applicant has not filed a certified copy of the Singapore patent

application 200207092-8 with a certified translation, if appropriate, as required by 35

USC 119(b), where the foreign applications were not filed in English. Please provide a

copy of the certified foreign application, including translation, if appropriate, because the

Examiner is unable to verify the priority date claimed by the Applicant. Examiner notes

that the Oath filed by the Applicant acknowledges that "NO" "Certified Copy (is)

Attached" of either "Prior Foreign Application" referenced in the Oath under 35USC

119(a)-(d).

Appropriate correction is required.

Specification Objections

4.   The disclosure is objected to because of the following informalities:

the foreign application priority claim data is missing from the first page of the

Specification, i.e., two patent applications filed by the Applicant in India or Singapore

are not cited as required by 35 USC 119. If the Applicant desires to claim the benefit of

a prior-filed foreign application under 35 USC 119, a specific reference to the prior-filed

foreign application in compliance with 37 CFR 1.78(a) must be included in the first

sentence(s) of the Specification following the title or in an application data sheet. For

benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the

relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on

or after November 29, 2000, the specific reference must be submitted during the pendency of the

application and within the later of four months from the actual filing date of the application or

sixteen months from the filing date of the prior application. If the application is a utility or plant

application which entered the national stage from an international application filed on or after

November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be

submitted during the pendency of the application and within the later of four months from the

date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months

from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time

period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or

120, where applicable, within this time period is considered a waiver of any benefit of such prior

application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the

required time period may be accepted if it is accompanied by a grantable petition to accept an

unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition

must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR

1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under

37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due

under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The

Director may require additional information where there is a question whether the delay was

unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for

Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period

set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application

data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath

or declaration or the application transmittal letter), and information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, **the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required.** Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11. (emphasis added here for *pro-se* Applicant)

Appropriate correction is required, i.e., please cite the original patent application numbers filed in India and Singapore in the Specification.

5.   The Specification also needs to be updated with respect to including a paragraph, 'Cross-Reference to Related Applications', to show many co-pending applications --- which were not identified initially, even though these were filed prior to the instant application (for example, #10/530,670) and the update should include currently co-pending applications also filed simultaneously with the instant application (for example, #10/530,668) by the same Applicant/ Inventor, "Dharam Pal".

Appropriate corrections are required by the Applicant as noted above.

Claim Objections

6.   Claims 1-9 are objected to because of the following informalities: All claims must start out with the language "I claim" according to MPEP 608.01 (m), and the dependent claims should be a separate clause after dependency claim, i.e., insert a comma after 'according to claim 1/2/..5/9/...', etc. in all dependent claims (2-9).

Appropriate correction is required.

7.   Claims 1-3, 5 and 7, as currently recited, end with a comma, which needs to be replaced with a full-stop/ period. Examiner has read these claims as such.

Appropriate correction is required.

8.   Claim 7 is objected to under 37 CFR 1.75(c) as being in improper form, because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, this claim has not been further treated on the merits.

Appropriate correction is required.

9.   Claim 8 is objected to under 37 CFR 1.75(c) as being in improper form, because a multiple dependent claim should refer to other claims in the alternative only and a multiple dependent claim cannot depend from any other multiple dependent claim (like Claim 7). See MPEP § 608.01(n). Accordingly, this claim has not been further treated on the merits.

Appropriate correction is required.

Double Patenting

10.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi,* 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum,* 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel,* 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of application no. 10/530668. Although the conflicting claims are not identical, they are not patentably distinct from each other, because they both provide similar online payment or credit information systems.

Claims 1-9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of application no. 10/530670. Although the conflicting claims are not identical, they are not patentably distinct from each other, because they both provide similar online systems for merchandising/ trading.

This is a <u>provisional</u> obviousness-type double patenting rejection, because the conflicting claims have not in fact been patented. Please file the disclaimers for the above mentioned patent applications.

Claim Rejections - 35 USC § 112

11.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-9, as best understood by the examiner, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase/term "System Administrator"/ "Administrator" recited in Claims 1-9 is vague and the Examiner asks the Applicants to clarify what type of entity it is in their reply, whether it is a human being or a computer (machine), and amend the requisite claims appropriately.

Examiner notes that the Specification can be used as a dictionary to learn the meaning of a term in the patent claim. *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999) ("[W]ords in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning."); *Renishaw PLC v. Marposs Societa" per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998) ("Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings."). See also MPEP § 2111.01.

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Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-9, as best understood by the Examiner, are rejected under 35

USC 103(a) as being unpatentable over US Patent No. 6,609,113 issued to Gordon

Cotter Cunningham filed on April 19, 1996 and titled: "Real-Time Financial Card

Application System" (hereinafter "Cunningham") in view of Publication No. US 2002/

0026410 filed by Woloshin et al. claiming priority from March 1, 2000 and titled:

"Paperless Online Merchant Account Approval and Provisioning System and Method

Therefor" (hereinafter "Woloshin") and further in view of US Patent No. 5,870,723

issued to Pare, Jr. et al. filed on August 29, 1996 and titled: "Tokenless Biometric

Transaction Authorization Method and System" (hereinafter "Pare") and further in view

of Publication No. US 2001/0018666 filed by Sugiyama et al. claiming priority from

February 2, 2000 and titled: "Settlement System Using Purchase Information"

(hereinafter "Sugiyama").

With respect to Claim 1, Cunningham teaches "An on-line credit information collection

and dissemination System which includes as participants a System Administrator,

Subscribers and Non-Subscribers, characterised in that a) System Administrator is an

independent entity, who operates the System, b) Subscribers and Non-Subscribers are

either individuals or businesses, c) Businesses and individuals register themselves

online on System Administrator's web site and become Subscribers, d) A Non-

Subscriber can only provide information on a Subject, he can not seek information on a

Subject through the System."   (see Cunningham Abstract and Summary,

and FIGs. 2 to 4 and their text)

Cunningham teaches as disclosed above, but it does not explicitly teach about 'business(es)', and
Woloshin teaches it as 'merchant(s)'.   (see Woloshin Abstract and Summary, and FIGs. 1
& 2 and their text)

It would have been obvious to an ordinary person of skill in the art at the time invention was
made to modify the teachings of Cunningham with those of Woloshin about 'merchants(s)'. The
motivation to combine these references would be to provide a quick system and method for
speedy processing of online approvals for merchants/businesses via a network/Internet that can
allow the equipment and process to be more productive and efficient in processing and approving
these accounts via the Internet without the need of having to wait for approval after applying
using a paper application.

With respect to Claim 2, Cunningham teaches "wherein said System Administrator

maintains a database of Subscribers and Non-Subscribers, wherein each Subscriber

has a System identifier (user ID/password) which is held by the Administrator and which

must be provided along with password at System Administrator's web site to seek

information on a Subject or provide information on a Subject; Administrator shall

validate a Subscriber and allow him to seek information and/or provide information on a

Subject through the System."   (see Cunningham Abstract and Summary,

and FIGs. 2 to 4 and their text)

Cunningham teaches as disclosed above, but it does not teach about 'user ID/password', and Pare teaches it as 'PIN and biometric codes'. (see Pare Abstract and Summary, and FIGs. 1 to 3 and their text)

It would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Cunningham with those of Pare about 'PIN and biometric codes'. The motivation to combine these references would be to provide a more secure system and method for speedy processing of online approvals for subscribers via a network/Internet that can allow the equipment and process to be more productive and efficient in processing and approving these accounts via the Internet almost instantaneously, and thus enhance the throughput of the system.

With respect to Claim 3, Cunningham teaches "wherein a Subscriber is required to make payment to the System Administrator while seeking information on a Subject through the System." (see Cunningham Abstract and Summary, and FIGs. 2 to 8 and their text)

Cunningham teaches as disclosed above, but it does not explicitly teach about 'payment', and Pare teaches it as debiting the account of the buyer and crediting the account of the seller in a transaction. (see Pare Abstract and Summary, and FIGs. 1 to 3 and their text)

It would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Cunningham with those of Pare about 'debiting the buyer's account and crediting the seller's account. The motivation to combine these references would be to provide a more secure system and method for speedy processing of online approvals for subscribers via a network/Internet that can allow the equipment and process to be more productive and efficient in processing and approving these accounts via the Internet almost instantaneously, and thus enhance the throughput of the system.

With respect to Claim 4, Cunningham teaches "wherein Subscribers and/or Non-Subscribers voluntarily provide information on a Subject to the information seeking Subscriber through the System; Information provided by a Subscriber and/or Non-Subscriber is either through a multiple choice method in a pre-determined template or in

the form of narration where he has the ability to write on a particular aspect of a

Subject."   (see Cunningham Abstract and Summary, and FIGs. 2 to 8 and their text)

With respect to <u>Claim 5</u>, Cunningham teaches "wherein information thus provided by

Subscriber and/or Non-Subscriber is made available only to the information seeking

Subscriber; Information seeking Subscriber is required to rate the best response from

among the various responses received by him; In the event of failure on the part of

information seeking Subscriber to rate the best response from among the responses

received by him he shall be charged a higher fee next time if he were to seek

information on a Subject through the System."   (see Cunningham Abstract

and Summary, and FIGs. 2 to 8 and their text)

Cunningham teaches as disclosed above, but it does not explicitly teach about 'payment', and
Pare teaches it as debiting the account of the buyer and crediting the account of the seller in a
transaction.   (see Pare Abstract and Summary, and FIGs. 1 to 3 and their text)

It would have been obvious to an ordinary person of skill in the art at the time invention was
made to modify the teachings of Cunningham with those of Pare about 'debiting the buyer's
account and crediting the seller's account. The motivation to combine these references would be
to provide a more secure system and method for speedy processing of online approvals for
subscribers via a network/Internet that can allow the equipment and process to be more
productive and efficient in processing and approving these accounts via the Internet almost
instantaneously, and thus enhance the throughput of the system.

With respect to <u>Claim 6</u>, Cunningham teaches "wherein System Administrator shall

carry out a lottery on periodic (daily/weekly/monthly) basis from among the various

Subscribers and/or Non-Subscribers whose responses have been rated the best by

respective information seeking Subscribers whereby a few respondents shall be

rewarded by distributing a substantial amount of fee paid by the seeking Subscribers

during that period; Information providing Subscribers and/or Non-Subscribers do not get

paid for providing information; Information providing Subscribers and/or Non-

Subscribers stand a chance to win large cash reward if their quality of response is

appreciated by the information seeking Subscriber."   (see Cunningham

Abstract and Summary, and FIGs. 2 to 8 and their text)

Cunningham teaches as disclosed above, but it does not explicitly teach about 'lottery', and
Sugiyama teaches it as a lottery with reward, award or prize.   (see Sugiyama Abstract and
Summary, and FIGs. 13 to 15 and their text)

It would have been obvious to an ordinary person of skill in the art at the time invention was
made to modify the teachings of Cunningham with those of Sugiyama about lottery with reward,
award or prize. The motivation to combine these references would be to provide a more secure
system and method for speedy processing of online approvals for subscribers via a
network/Internet that can allow the equipment and process to be more productive and efficient in
processing and approving these accounts via the Internet almost instantaneously, and thus
enhance the throughput of the system.

With respect to Claim 7, Cunningham teaches "wherein said Administrator database

stores a pre-determined template containing various fields relevant to a Subject that

shall form part of the credit information report on a Subject provided by a Subscriber

and/or Non-Subscriber to an information seeking Subscriber."   (see

Cunningham Abstract and Summary, and FIGs. 2 to 8 and their text)

With respect to Claim 8, Cunningham teaches "wherein System Administrator makes

use of the same process of collecting and disseminating information for other purposes

i.e. on celebrities, on places, on issues etc." (see Cunningham Abstract and

Summary, and FIGs. 2 to 8 and their text)

With respect to <u>Claim 9</u>, Cunningham teaches "wherein potential Subscribers provide

their bank account details at the point of registration to be admitted to the System as

Subscribers so that they would be able to receive cash rewards for giving quality

information on Subjects to the information seeking Subscribers." (see Cunningham

Abstract and Summary, and FIGs. 2 to 8 and their text)

Cunningham teaches as disclosed above, but it does not explicitly teach about 'lottery', and
Sugiyama teaches it as a lottery with reward, award or prize. (see Sugiyama Abstract and
Summary, and FIGs. 13 to 15 and their text)

It would have been obvious to an ordinary person of skill in the art at the time invention was
made to modify the teachings of Cunningham with those of Sugiyama about lottery with reward,
award or prize. The motivation to combine these references would be to provide a more secure
system and method for speedy processing of online approvals for subscribers via a
network/Internet that can allow the equipment and process to be more productive and efficient in
processing and approving these accounts via the Internet almost instantaneously, and thus
enhance the throughput of the system.

Conclusion

13.   The prior art made of record and not relied upon is considered pertinent to

Applicant's disclosure is:

1. Pub. No. US 2001/ 0034720 filed by David Armes claiming priority from

   March 7, 2000 and titled: "System for Facilitating a Transaction".

2. Pub. No. US 2004/ 0158532 filed by Breck et al. claiming priority from

   March 7, 2000 and titled: "System for Facilitating a Transaction".

3. Pub. No. US 2005/ 0055231 filed by Geoffrey C. Lee claiming priority from September 8, 2003 and titled: "Candidate-Initiated Background Check and Verification".

4. US Patent No. 6,856,975 issued to Frank Inglis and titled: "System, Method, and Article of Manufacture for Secure Transactions Utilizing a Computer Network" filed on March 30, 2000.

14.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanjeev Malhotra whose telephone number is 571-272-7292. The examiner can normally be reached on Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
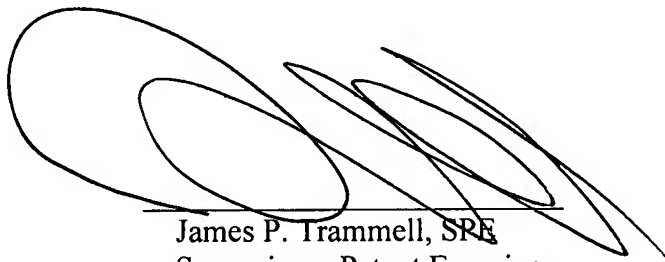
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

15.   Examiner's Note: Examiner has cited particular columns and line numbers in the

references as applied to the claims for the convenience of the applicant. Although the specified

citations are representative of the teachings in the art and are applied to the specific limitations

within the individual claim, other passages and figures may apply as well. It is respectfully

requested from the applicant, in preparing the responses, to fully

consider the references in entirety as potentially teaching all or part of the claimed invention, as

well as the context of the passage as taught by the prior art or disclosed by the examiner.

SM
November 8, 2007

James P. Trammell, SPE
Supervisory Patent Examiner